

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application of:)
LEAMING)
Serial No. 10/829,007) Examiner: E. Unelus
Filing Date: April 21, 2004) Art Unit: 2181
For: SMART CARD WITH SELF-)
RECONFIGURATION FEATURES AND)
RELATED METHODS)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the final Official Action of January 12, 2007, and in connection with the Notice of Appeal filed concurrently herewith, please enter the remarks set out below.

REMARKS

Based upon the arguments presented below, Applicant respectfully requests the Pre-Appeal Brief Review Conference Panel (Panel) reconsider and withdraw the Examiner's rejections of the claims.

I. The Claimed Invention:

As recited in independent Claim 1, for example, the present invention is directed to an integrated circuit for a smart card which includes a transceiver and a processor for

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communicating with a host device over a system bus via the transceiver. The processor is for providing at least one default descriptor to the host device, and cooperating with the host device to perform an enumeration based upon the at least one default descriptor. Moreover, the processor is also for providing at least one alternate descriptor to the host device and cooperating with the host device to perform a new enumeration based thereon based upon allocations of system bus bandwidth to other devices communicating with the host device over the system bus.

Independent Claims 10, 19, and 28 are directed to a related smart card, smart card system, and method, respectively. Similar to Claim 1, each of these claims also includes the claimed element that a new enumeration is performed based upon allocations of system bus bandwidth to other devices communicating with the host device over the system bus, and this element is clearly not found in the prior art references cited by the Examiner.

II. The Claimed Invention:

The Examiner rejected independent Claims 1, 10, 19, and 28 based upon U.S. Published Patent Application No. 2005/0251596 to Maier in view of U.S. Published Patent Application No. 2005/0108571 to Lu et al. The Examiner initially appears to indicate in the Response to Arguments section of the Final Office Action (see page 2) that Maier somehow teaches the above-noted

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recitation in FIG. 1 and paragraph 0055 thereof. However, on page 5 of the argument the Examiner appears to correctly acknowledge that Maier does not properly provide this claimed element, but then contends that FIG. 2 of Lu somehow does. See page 5 of the Final Office Action. Each of these assertions will be discussed in turn.

Maier is directed to a USB system including a main device and an auxiliary device arranged to co-operate with one another. The auxiliary device provides a core functionality and has descriptors associated therewith. The auxiliary device has at least one descriptor that defines a functionality that is different from the core functionality. See, e.g., paragraph 0016-0019 of Maier.

In particular, the purpose of the Maier system is to initially present a USB smart card device to a computer as a generic mass storage device so that it will be recognized by the computer without any special device drivers or applications installed on the computer. Thus, by simulating a mass storage device, a user is able to then install an application driver on the computer so that the smart card can subsequently be used for its desired purpose (i.e., as an internet login smart card) when re-enumerated (i.e., re-connected) with the host computer. See, e.g., paragraphs 0017 and 0018 of Maier.

As for FIG. 1 of Maier, the Examiner states that this figure "discloses communications between the device and the host." Final Office Action, page 2. Even so, this does not

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provide the above-noted recitation. With respect to paragraph 0055, which is reproduced below, this paragraph merely discusses performing the second enumerating step listed above so that the different services or applications installed when the smart card was previously connected in the mass storage mode can be used. That is, this paragraph simply discusses the step of re-enumerating the smart card to be an internet login card once the appropriate application has been installed on the computer, as noted above. Nowhere does this nor any other portion of Maier teach that the re-enumeration is performed based upon allocations of system bus bandwidth to other devices communicating with the host device over the system bus.

"[0055] in a second enumerating step ENUM2, the USB host enumerates the USB device. As illustrated in FIG. 2, only the descriptors (II) associated to the services (**S1, S2, S3**) which have been activated and the descriptor associated to the standard service (**S0**) will be retrieved."

Maier, paragraph 0055.

Turning to Lu et al., this reference is directed to a smart card that is capable of acting as a network node providing secure communication to other nodes on a network. See, e.g., paragraph 0022 of Lu et al. Nonetheless, even though FIG. 2 of Lu et al. shows the smart card connected in a network with other devices as the Examiner notes, this still does not provide the claimed recitation of a smart card that re-enumerates itself

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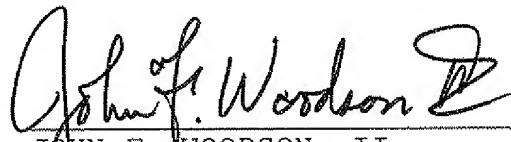
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using an alternate device descriptor based upon allocations of system bus bandwidth to other devices communicating with the host device over the system bus. Neither does any other portion of Lu et al. provide this claimed element.

Accordingly, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness, as neither of the cited prior art references provides the above-noted claim recitation. It is therefore submitted that independent Claims 1, 10, 19, and 28 are patentable over the prior art. Their respective dependent claims, which recite yet further distinguishing features, are also patentable over the prior art and require no further discussion herein.

Respectfully submitted,



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